

Remarks/Arguments

This Amendment is in response to the Office Action mailed October 2, 2003. Claims 1-8 are pending in this case. Claims 1-8 have been rejected. Claims 1 and 8 have herein been amended. Claims 2-7 remain unchanged. New Claims 9-20 have herein been added.

Claim 8 has been objected to because of a minor informality, and has been amended accordingly. It is respectfully submitted that the objection to Claim 8 has been overcome by way of this Amendment.

Claims 1 and 3-4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. (US 5,768,132). For the following reasons, the Examiner's rejection is respectfully traversed.

Cordery et al. does not make obvious Applicants' Claims 1, 3 and 4 under 35 U.S.C. 103(a). Cordery et al., unlike Applicants' method for providing traceability of mail pieces, relates to a controlled acceptance mail system for securely enabling reuse of digital token initially generated for a mailpiece on a subsequently prepared different mailpiece to authenticate payment of postage. In other words, Cordery et al. only relates to and discloses a method and system for securely allowing metered postage printed on a first envelope to be re-used on a second envelope if the first envelope not used or mailed. Cordery et al. is in no way concerned with encrypted source identification of mail pieces for mail security and traceability.

Applicants, on the other hand, claim a method for providing traceability of mail pieces, wherein an encrypted source identification code is provided on each of the plurality of mail pieces via source identification code producing equipment. Cordery et al. does not teach, disclose or suggest providing a source identification code on each of the plurality of mail pieces and on a mailing statement, as in Claim 1.

As admitted in the Office Action, Cordery et al. fails to teach or fairly suggest that the first identification code and the second identification code of Cordery et al. correspond to a source of the mail piece. However, the Examiner's rejection concludes, without support, that it would have been obvious to modify the Cordery et al. to provide a capability of identifying the mailer, and that such a modification would have been an obvious extension of Cordery et al. This is not the case. There is nothing in Cordery et al. which would teach or suggest the proposed modification. Again, Cordery et al. is not concerned with source identification of mail pieces for mail security and traceability, and thus does not provide the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Cordery et al. is only concerned with securely reusing previously metered postage; and as such, the proposed modification would not have been an obvious extension of the teachings of Cordery et al. All references to encryption in Cordery et al. are concerned with postage, and not with encrypted source identification, as in

Claim 3. Similarly, all references to a digital token in Cordery et al. are concerned with accounting for postal charges using a meter imprint, not with source identification codes, as in Claim 4.

For the above reasons, Applicants respectfully submit that the Cordery et al. does not make obvious Applicants' Claims 1, 3 and 4 as set forth herein, and that those claims are allowable over Cordery et al. It is respectfully requested that the Examiner reconsider and remove the above stated rejection.

Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. in view of Pintsov (US 6,009,416).

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. in view of Leon (US 20030028497).

Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. in view of Parkos (US 5,912,682).

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. in view of Berson (US 5,929,415).

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. in view of Petkovsek (US 5,918,802).

For the following reasons, the Examiner's rejections are respectfully traversed.

The proposed combinations does not make obvious Applicants' respective independent Claims 2 and 5-8 under 35 U.S.C. 103(a). The primary reference Cordery et al. fails to meet the limitations of

independent Claim 1 for the above stated reasons, and further admittedly fails to teach or suggest the limitations in dependent Claims 2 and 5-8. Each of the cited secondary references fails to make up for the deficiencies of Cordery et al. with respect to the limitations in the base Claim 1. As such, the proposed combinations fail to render the respective claims obvious.

Additionally, with respect to Claim 2, Pintsov is being cited to make up for Cordery et al.'s failure to teach or suggest the step of verification using a "barcode scanner." The Examiner's rejection states that it would have been obvious to incorporate a barcode reader into the system of Cordery et al. in order to provide a faster and more accurate system. The Examiner's rejection also admits that the proposed combination fails to teach or fairly suggest the step of scanning the second identification from the mailing statement to verify it with the first identification code. However, the Examiner's rejection concludes, without support, that it would have been obvious to incorporate a barcode reader into the verification system of the proposed combination to provide a faster and more accurate system, and that such a modification would have been an obvious extension of the proposed combination. This is not the case. It is noted that Applicants' Claim 2 does not refer to using a barcode scanner. Further, there is nothing in either reference which would teach or suggest the proposed modification. Neither reference

is concerned with encrypted source identification of mail pieces for mail security and traceability, and thus neither provides the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Both references are concerned with accounting for postal charges, and thus, the proposed combination fails to meet the steps of scanning and verifying source identification codes, as required by Claim 2. As such, the proposed modification would not have been an obvious extension of the teachings of the proposed combination.

With respect to Claim 5, Leon is being cited to make up for Cordery et al.'s failure to teach or suggest that the first identification code is embedded into a watermark. The Examiner's rejection states that it would have been obvious to incorporate "an invisible barcode as taught by Benson" [sic] into the teachings of Cordery et al. in order to provide "a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator." This is not the case. It is also noted that Claim 5 does not claim an "invisible barcode." Leon relates to authenticating postage labels, and is concerned with the prevention of fraud in the printing of postage labels. Neither reference is concerned with encrypted source identification of mail pieces for mail security and traceability, and thus neither provides the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Both

references are concerned with accounting for postal charges using a meter imprint, and thus, the proposed combination fails to meet the limitation of a source identification code being embedded into a watermark, as in Claim 5. As such, the proposed combination fails to make obvious Applicants' Claim 5.

With respect to Claim 6, Parkos is being cited to make up for Cordery et al.'s failure to teach or suggest that the first identification code is embedded into paper fibers. Parkos is said to teach that "postage indicia 10' is embedded into paper fibers." The Examiner's rejection states that it would have been obvious to incorporate "*the use of paper fibers*" into the teachings of Cordery et al. in order to provide "*a capability of protecting the code/indicia from being damaged while handling or transporting and sorting the mails, thus providing a more accurate system.*" This is not the case. Parkos relates to printing a postage meter indicia using inks having certain characteristics such as being water fast. While the ink in Parkos is absorbed into the fibers of the envelope to be water fast, there is no teaching or suggestion in Parkos to embed a source identification code into the paper fibers. Neither reference is concerned with encrypted source identification of mail pieces for mail security and traceability, and thus neither provides the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Neither reference is concerned with source

identification codes, and thus, the proposed combination fails to meet the limitation of a source identification code being embedded into paper fibers, as in Claim 6. As such, the proposed combination fails to make obvious Applicants' Claim 6.

With respect to Claim 7, Berson is being cited to make up for Cordery et al.'s failure to teach or suggest that the first identification code embedded into is invisible ink. Berson is said to teach that "a barcode 31 is invisible." The Examiner's rejection states that it would have been obvious to incorporate "an invisible barcode as taught by Benson" [sic] into the teachings of Cordery et al. in order to provide "a more secure system, preventing the code from being manipulated by a mailer or an unauthorized operator." This is not the case. Berson relates to a postage metering refill system that utilizes information contained in information based indicia to audit the franking process. Neither reference is concerned with encrypted source identification of mail pieces for mail security and traceability, and thus neither provides the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Both references are concerned with accounting for postal charges in meter imprint, and thus, the proposed combination fails to meet the limitation of a source identification code being embedded into invisible ink, as in Claim 7. As such, the proposed combination fails to make obvious Applicants' Claim 7.

With respect to Claim 8, Petkovsek is being cited to make up for Cordery et al.'s failure to teach or suggest the step of capturing and recording the identity of an individual submitting the plurality of mail pieces. Petkovsek is said to teach "a signature, which serves as the identity of the sender or an individual submitting the plurality of mail pieces." The Examiner's rejection states that it would have been obvious to incorporate "the step of capturing and recording the signature/identity of the sender as taught by Petkovsek" into the teachings of Cordery et al. in order to provide "a more secure system wherein the identity of the sender can be identified/retrieved readily." This is not the case. Petkovsek relates to a special service envelope and a method for mailing a mailpiece requiring a special service, such as certified mail. Neither reference is concerned with encrypted source identification of mail pieces for mail security and traceability, and thus neither provides the required teaching or suggestion for the proposed modification under 35 U.S.C. §103. Providing a signature does not meet the Claim 8 limitation of capturing and recording the identity of an individual, especially where anyone can sign anyone else's name; thus, the identify of the signor has not been captured or recorded. As such, the proposed combination fails to make obvious Applicants' Claim 8.

New Claims 9-20 have been set forth to further particularly point out and distinctly claim Applicants' method for providing traceability of mail pieces, as set forth therein. For the above reasons, it is respectfully submitted that these new claims are likewise patentable over the prior art of record.

It is respectfully submitted that none of the prior art of record, either alone or in combination, fairly teaches, suggests or discloses the novel and unobvious features of Applicants' claimed invention. Accordingly, Applicants respectfully assert that the claims as presented herein are now in condition for allowance. An early notice allowance is respectfully requested.

Any arguments of the Examiner not specifically addressed should not be deemed admitted, conceded, waived, or acquiesced by Applicants. Any additional or outstanding matters the Examiner may have are respectfully requested to be disposed of by telephoning the undersigned.

A Petition for an Extension of Time is enclosed along with a form PTO-2038 authorizing a credit card charge to cover the extension fee. The Commissioner is hereby authorized to charge any additional fees which may be required, including if necessary the above fee if there is any problem with the credit card charge, to Deposit Account No. 16-0657.



A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

PATULA & ASSOCIATES, P.C.

A handwritten signature in cursive script, appearing to read "Charles T. Riggs Jr.".

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